UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/029,111
Filing Date: December 21, 2001
Appellant(s): ABBA ET AL.

Neil M. Batavia
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/14/07 appealing from the Office action mailed 5/18/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,990,377	Chen et al.	11-1999
WO 98/42289	Chen et al.	10-1998

(9) Grounds of Rejection

New Grounds of Rejection

The following new ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. WO 98/42289.

4. As to claims 1-3, 6, 16, 17, 19, 37, 38, and 43, Chen discloses the present invention substantially as claimed. Given the broadest reasonable interpretation, the base sheet 1 in Figure 13 comprises peaks and valleys. The base sheet 1 comprises the same material and the same percentage of composition for the peaks and valleys. The addition of the fibrous material on the peaks creates a greater density on the peaks.

Chen does not specifically disclose the web height is at least 25% greater than the average caliper of the web. However, Chen does disclose a web having peaks and valleys, which are greater than the average caliper of the web. Thus, the general conditions of the claim are disclosed. Chen discloses the depth of the elevated and depressed regions is such that it creates an absorbent web having a dry feel when wet (page 9, paragraph 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the claimed relationship between the web height and web caliper since where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Chen discloses a textured airlaid fibrous web comprising natural fibers, synthetic fibers, or mixtures thereof (page 37, paragraph 12). The limitation of "the airlaid web being formed on a three-dimensional fabric under sufficient force to cause the web to conform to the surface of the fabric" is directed to a process of making the article. "Even though product-by-process

claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113. The textured web includes a repeating pattern of peaks and valleys, the textured web having a height that is at least 25% greater than the average caliper of the web (Figure 13), the airlaid web is bonded together (page 38, lines 9-11).

As to claims 4 and 5, the methods of bonding directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 7, see page 35, last paragraph through page 36, first paragraph.

As to claim 8, see page 54, paragraph 1.

As to claims 9-13, see page 40, paragraph 3 through page 41, paragraph 1.

As to claim 14, 15, 20, 41, 42, and 44, Chen discloses the present invention substantially as claimed. Chen does not specifically disclose the claimed heights and surface area. Chen does disclose a textured airlaid web having peaks and valleys above a base sheet for the purpose of wicking fluids. Where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

As to claim 18, see Figure 3.

As to claims 20-26, the limitations regarding the type of are directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations. In this case, the structure of Chen is capable of functioning as an absorbent product for a variety of uses, such as a diaper or wiper product.

As to claim 27, see page 47, paragraph 2.

As to claims 28, 30, and 31, Chen discloses an airlaid fibrous web at least one textured surface including peak areas and valley areas, the peak areas and the valley areas forming a repeating pattern on the surface of the web (Figure 13). the airlaid web having a height that is at least 25% greater than the average caliper of the web, the web including at least one peak area per inch in one direction of the web (page 40 paragraph 3 through page 41, paragraph 1), the airlaid web being bonded together (page 38, lines 9-11).

As to claim 29, the limitation of "the airlaid web being formed on a three-dimensional fabric under sufficient force to cause the web to conform to the surface of the fabric" is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 32, see page 35, last paragraph through page 36, paragraph 1.

As to claims 33-36, see page 40, paragraph 3 through page 41, paragraph 1.

As to claim 39, see page 47, paragraph 2.

As to claim 40, see Figure 13.

As to claim 45, see page 38, lines 20-27.

As to claim 46, Chen discloses the present invention substantially as claimed. However, Chen does not specifically the peak areas have a first density and the valley areas have a second density, the first density being at least 100% greater than the second density. However, Chen discloses varied amounts of material may be applied to the peaks, including multiple applications of different materials (page 48, paragraph 1). The more material applied to the peaks, the greater the density in the peak area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Chen with the claimed density, since discovering an optimum value of a result effective variable involves only routine skill in the art.

As to claims 47, given the broadest reasonable interpretation, the base sheet 1 in Figure 13 comprises peaks and valleys. The base sheet 1 comprises the same material and the same percentage of composition for the peaks and valleys. The addition of the fibrous material on the peaks creates a greater density on the peaks.

Chen does not specifically disclose the web height is at least 25% greater than the average caliper of the web. However, Chen does disclose a web having peaks and valleys, which are greater than the average caliper of the web. Thus, the general conditions of the claim are disclosed. Chen discloses the depth of the elevated and depressed regions is such that it creates an absorbent web having a dry feel when wet (page 9, paragraph 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the claimed relationship between the web height and web caliper since where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Chen discloses a textured airlaid fibrous web comprising natural fibers, synthetic fibers, or mixtures thereof page 37, paragraph 2). The limitation of "the airlaid web being formed on a three-dimensional fabric under sufficient force to cause the web to conform to the surface of the fabric" is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re

Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113. The textured web includes a repeating pattern of peaks and valleys, the textured web having a height that is at least 25% greater than the average caliper of the web (Figure 13), the web including the claimed peak areas per inch of the web (page 40, paragraph 3 through page 41, paragraph 1), the airlaid web being bonded together (page 38, lines 9-11), and the airlaid web having a basis weight of at least 40 gsm (page 54, paragraph 1). Chen also teaches some hydrophobic matter is present in the valley, albeit not as much as is present in the peaks (page 11, paragraph 2). Additionally, Figure 13 of Chen shows the base sheet also 'comprises' the peaks and underlies the hydrophobic matter. Therefore, based on the teaching of Chen, the peaks and valleys both contain hydrophobic matter as well as hydrophilic material.

(10) Response to Argument

1. Applicant's arguments filed 5/14/07have been fully considered but they are not persuasive. Applicant has provided statement that Chen and the present application were both subject to assignment to Kimberly-Clark Worldwide, Inc. at the time the invention was made. Since Applicant has made this statement for the first time with the filing of the Appeal Brief, a new grounds of rejection is made in this Examiner's Answer. The new grounds is made under WO 98/42289 Chen et al. Applicant has provided arguments in anticipation of a new grounds of rejection under Chen WO 98/42289. The response to the arguments follows.

Applicant argues Chen teaches away from the percentage of composition of material making up the peaks being the same as the percentage of composition of material making up the valleys in that in Chen, the percentages of composition are different between the peaks and valleys. Applicant argues Chen discloses the depressed regions 4 should have a significantly lower amount of hydrophobic matter in order to achieve the stated goals. However, as previously stated by the Examiner, this argument is not persuasive in that the base sheet, which constructs the peaks and valleys is made of the same material and therefore, has the same percentages of composition. The fibers on the surface of the peaks are an additional material. The 'comprising' language used in the independent claims is inclusive or open-ended and does not exclude additional unrecited elements, compositional components, or steps.

Applicant repeats the argument that the modification of Chen to achieve the structure set forth in the pending claims is result of hindsight reasoning. As previously argued by the Examiner, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As to the height of the web, Chen provides a teaching of an Overall Surface Depth of 0.2mm or *greater*, which provides a teaching of a greater web height.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Jacqueline F. Stephens
Primary Examiner, Art Unit 3761

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:

Tatyana Zalukaeva,
Supervisory Primary Examiner, Art Unit 3761

Angela Sykes,
Supervisory Primary Examiner, Art Unit 3762